

REMARKS

In the Final Office Action mailed from the United States Patent and Trademark Office on June 6, 2006, claims 1-14, 16-19 and 21-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,571,245 to Huang et al. (hereinafter “Huang”), in view of U.S. Patent Number 6,339,787 to Yohe et al. (hereinafter “Yohe”), and further in view of U.S. Patent No. 6,728,760 to Fairchild et al. (hereinafter “Fairchild”). The Examiner also rejected claims 20 and 26 under 35 U.S.C. §103(a) as being unpatentable over Huang, Yohe, and Fairchild and further in view of U.S. Patent Number 6,122,351 to Schlueter, Jr. et al. (hereinafter “Schlueter”). Accordingly, Applicants respectfully provide the following.

Claim Rejections under 35 U.S.C. §103(a):

As mentioned above, the Examiner rejected all claims under 35 U.S.C. §103(a) as being unpatentable over various combinations of references including Huang and Yohe in view of Fairchild. In light of these rejections, Applicants provide the following remarks.

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). This standard is particularly helpful in evaluating the first two *Graham* factual enquiries of the scope and content of the prior art and the differences between the prior art and the claims at issue. Applicants respectfully submit that the references cited in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicants also respectfully submit that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

In the Office Action, the Examiner addressed Applicants' detailed explanation of why the cited art references fail to teach all claim limitations with a single form paragraph indicating that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. (See Office Action at page 16, paragraph 5.)

Applicants respectfully submit that Applicants did not attack the references individually, but that Applicants provided a detailed explanation of why the cited references, alone or in combination, do not teach all elements of the claims. Applicants provided a detailed explanation addressing why the cited references could not be relied upon for teaching the recited claim elements for which they were relied on. Therefore, Applicants have shown that the cited

references fail to teach all elements of the claim limitation, for if none of the cited references teach the recited claim elements, then a combination of the cited references also fails to teach the claim elements.

Also in the Office Action, the Examiner addressed Applicants' three-page detailed explanation of why one of ordinary skill in the art would not combine the references in the manner suggested in the Office Action with a single paragraph that provided no analysis of Applicants' discussion. Applicants have provided an in-depth analysis of what is taught by the cited references and how one of skill in the art would understand and apply the teachings of the various references. Applicants respectfully request that the Examiner consider Applicants' arguments, including the cited portions of the references themselves, before alleging that one of skill in the art would combine references to obtain supposed advantages that would not be sought by one of skill in the art and would not be obtained by the proposed combination.

Failure of the art to teach all claim limitations:

All independent claims include language that clearly distinguishes over the cited art.

Claim 1 includes language requiring:

information access control controlling the sharing of information requested by the at least one client by maintaining a list of those clients requesting the information and forwarding updates of the information as the updates occur to those clients on the list only, wherein the information access control includes a smart cache controller to manage information accessed by one or more clients, and wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information.

Applicants respectfully submit that this limitation is not taught by the cited references, alone or in combination.

Specifically, Applicants set forth below the above-recited claim limitation, drawing from the Office Action the cited portions of the cited references relied on to reject the claim limitation:

information access control controlling the sharing of information requested by the at least one client by maintaining a list of those clients requesting the information and forwarding updates of the information as the updates occur	Huang, Col 18, lines 27-46
to those clients on the list only,	Fairchild Col 2 line 27-Col 3 line 28
wherein the information access control includes a smart cache controller to manage information accessed by one or more clients, and wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information	Huang, Col 18, lines 27-46 Yohe Col 3 & 4, Col 3 lines 36-65, and Col 9 lines 36-65

In addition, Applicants set forth below those portions of the above-recited claim limitation that are acknowledged in the Office Action as not being taught by one or more of the cited references:

information access control controlling the sharing of information requested by the at least one client by maintaining a list of those clients requesting the information and forwarding updates of the information as the updates occur	Huang
to those clients on the list only,	Admittedly not taught by Huang
wherein the information access control includes a smart cache controller to manage information accessed by one or more clients, and wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information	Huang Admittedly not taught by the combination of Huang and Fairchild

From the above comparison, it may clearly be seen what portions of the recited claim limitations are suggested by the Office Action as being taught, suggested, or read upon by the cited art references, and which portions are admitted as not being taught by one or more of the references. Applicants have previously shown, in detail, why the cited references fail to teach the elements of the above claim limitation, and do so again here.

Regarding the last element of the above claim limitation, “wherein the information access control includes a smart cache controller to manage information accessed by one or more clients, and wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information,” the Office Action clearly indicates that the combination of Huang and Fairchild fails to teach this claim element. (See Office Action at page 4, first full paragraph.) Therefore, if Yohe fails to teach this claim element, then none of the cited references teach this element. If none of the cited references teach this element, a combination of the teachings of all the references, even if properly motivated and feasible, also fails to teach this element. Applicants have previously shown that Yohe does not teach this element, and do so again:

Applicants respectfully contend that Yohe does not teach “wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information,” as is required by claim 1. Yohe does not teach that updates are shared only with clients requesting information and contained on any list, does not teach forwarding information based on registered interests of the clients in the

information, and does not teach forwarding updates of the information as the updates occur.

(None of these specific limitations is taught by the cited portions of Columns 3, 4, or 9 of Yohe, relied upon in the Office Action.)

Yohe specifically teaches that updates to information contained in cached stores are updated in response to specific action requests by a requesting computer, not “as the updates occur.” (See Col 9 lines 29-45 (Open request), Col 9 lines 46-60 (Read request), Col 10 lines 21-32 (Write request), for example.) Thus, Yohe not only fails to teach instantaneously sharing and forwarding updates as the updates occur, but teaches away from the claimed element in that updates are passed along only as requested. No listing of clients requesting the information and with registered interest in the information is disclosed at all. Therefore, Yohe fails to teach the claim element that has been admitted as not being taught by the combination of Huang and Fairchild. Since none of the references teach such claim element, the combination of references also fails to teach this claim element.

Regarding the claim element of “information access control controlling the sharing of information requested by the at least one client by maintaining a list of those clients requesting the information and forwarding updates of the information as the updates occur, to those clients on the list only” the Office Action clearly indicates that Huang fails to teach this claim element. (See Office Action at page 3, third paragraph.) Therefore, if Fairchild and Yohe also fail to teach this claim element, then none of the cited references teach this claim element. If none of the cited references teach the claim element, then the combination of references also fails to teach

the claim element, even if the combination of references is properly motivated and feasible.

Applicants have previously shown that Fairchild does not teach this element and do so again:

The Office Action relies on Fairchild as teaching forwarding an update, as it occurs, citing column 2, line 27-column 3, line 28. Applicants respectfully disagree with this reading of Fairchild. Fairchild does not teach the forwarding of an update of the discussed media files, let alone the claimed “forwarding updates of the information as the updates occur to those clients on the list only.” Claim 1 requires the forwarding of updates of the actual information as the updates occur, not of a mere notification that the information has been changed as the update occurs, with a later request for the updated information from those receiving the notification. This is what is actually taught by Fairchild, and therefore Fairchild fails to teach what is acknowledged as not being taught by Huang.

Fairchild teaches a system for delivery of computer media over a network of computers wherein when a media file is updated, a mere notification of the update may be sent out to those computers maintaining a shortcut link to the information or having a copy of the media file. (Abstract lines 15-19, Col 2 lines 48-58, Col 5 lines 3-8, Col 6 lines 59-65, for example.)

However, the updated media files are not actually sent out with the notification, but are later downloaded separately by those desiring the updated media files. (Col 3 lines 48-54, Col 7 lines 41-51, for example.) Therefore, though Fairchild teaches sending out a notification of updates when the updates occur, Fairchild does not teach the claimed limitation of “forwarding updates of the information (analogous to the media files of Fairchild) as the updates occur.”

Yohe also fails to teach such claim elements, for the same reasons set forth above. In Yohe, updates are not sent out “as the updates occur,” as is required by claim 1. Yohe

specifically teaches that updates to information contained in cached stores are updated in response to specific action requests by a requesting computer, not “as the updates occur.” (See Col 9 lines 29-45 (Open request), Col 9 lines 46-60 (Read request), Col 10 lines 21-32 (Write request), for example.) Thus, Yohe not only fails to teach or suggest the recited claim element, but teaches away from the claim element in that updates are passed along only as requested. Therefore, Yohe also fails to teach the claim element that has been admitted as not being taught by Huang and that has been shown above as not being taught by Fairchild. Since none of the references teach such claim element, the combination of references also fails to teach this claim element.

Therefore, for at least the above reasons, Applicants respectfully submit that none of the cited references, alone or in combination, teach the above-discussed limitations. Neither Huang, nor Fairchild, nor Yohe, nor any combination thereof, teaches the above-discussed claimed elements of “maintaining a list of those clients requesting the information and forwarding updates of the information as the updates occur to those clients on the list only” and a smart cache controller “wherein the smart cache controller uses instantaneous, real time smart cache refreshing to instantaneously share and forward updates of the information as the updates occur to those clients on the list only based on registered interests of the clients in the information.” Because the cited references, alone or in combination, fail to teach the claimed language, Applicants respectfully submit that claim 1 is not made obvious by the cited combination of references.

Lack of motivation to combine references in the manner suggested in the Office Action:

Applicants further submit that one of skill in the art would not be motivated to combine references in the manner suggested in the Office Action. There is no adequate reason set forth in the Office Action that explains why one of skill in the art would take the three cited references that fail to show all claim limitations, as set forth above, and modify them to arrive at the claimed invention. Huang and Yohe fail to suggest the combination of the prior art references suggested by the Examiner.

The Office Action indicates that one of skill in the art would be motivated to combine Huang and Fairchild to keep the “subscribed” users instantly informed of changes, and indicates that the motivation to do so is based on knowledge generally available to one of ordinary skill in the art. Applicants have reviewed Huang and Fairchild and have found no reference to “subscribed” users being instantly informed of changes. Additionally, even accepting that Fairchild provides some information of changes to interested users, nothing in Huang suggests that providing such information is useful in the Huang calendar system. The purpose of Huang is to allow others to access and update a single user’s calendar. The very updating of Huang’s calendar already provides that information to the user whose calendar is updated. Nothing in Huang suggests that any other users, let alone “subscribed” users need or want to be informed of changes to the user’s calendar. Therefore, there is clearly no motivation to combine Fairchild and Huang in the manner suggested in the Office Action.

Furthermore, in the Office Action, the Examiner alleged that one of skill in the art would be motivated to modify Huang and Fairchild in view of Yohe. The Examiner indicated that one of skill in the art would be motivated to do so “because it helps increase data access in a

network,” citing Yohe column 3 line 37. Applicants respectfully disagree. While Yohe teaches a caching system that increases the speed of data access in a network, the method it uses is complicated and requires a fair amount of processing power. Specifically, the Yohe method requires generating a data signature for each block of data to be accessed at a client computer and at a file server/cache verifying computer. (Col 3 lines 43-56) This extra processing use is justifiable in the case of slower network access conditions, such as in a slow modem connection, as the extra time used is offset by the saved time in not re-downloading identical information over the slow connection. (Col 2 line 64-Col 3 line 11) However, this system does not provide the benefit cited by the Examiner of helping “increase data access in a network” for the system claimed in claim 1.

Specifically, as discussed above, the system of Yohe does not provide updates as they occur to other clients, but only provides a comparison upon request between the information on one client and on the file server. (See Yohe Figure 2, and the discussion above.) Thus, adding Yohe to Huang does not solve the problems solved by Applicants’ claimed invention. Furthermore, the system of Huang uses its own system for updating and synchronizing file information between file servers and the computer using the web-based virtual desktop that uses minimal network resources, far less processing power than used by the system of Yohe, and achieves all the needs of Huang. Specifically, Huang uses synchronization based on the last edit date of the to-be-synchronized file on each system. (Col 12 lines 20-29) Thus, one examining the systems of Huang and Yohe would not be motivated to combine the references, as no advantage would be provided from the combination, especially as it relates to updating the calendaring database of Huang relied upon in the Office Action.

In the Office Action, the Examiner has failed to address Applicants' arguments regarding the failure of Yohe to teach any motivation to combine the references and the fact that one of ordinary skill in the art would in fact readily recognize that no advantages would be achieved by the proposed combination. Instead, the Examiner merely cited again to a single phrase of Yohe that reads, in its entirety, "an apparatus for increased data access in a network." Upon consideration of the Section 103 rejection as a whole, and the teachings of the three references, as a whole, as requested by the Examiner, it is clear that one of ordinary skill in the art would not be motivated to combine the three references in the manner suggested. Applicants therefore respectfully request that the Examiner address, in detailed fashion, Applicants' above arguments.

Additional Considerations:

Applicants respectfully submit that under an appropriate Section 103 analysis, it is clear that at the time of the invention, with no knowledge of the present invention, an artisan of ordinary skill would not have combined Huang, Fairchild, and Yohe in the manner suggested by the Examiner. Only by inappropriately using the roadmap of the present invention would an artisan of ordinary skill combine these three references in such a manner. In essence, Applicants urge that the combination of the listed references is not a product of a suggestion contained within them, but a product of inappropriate hindsight analysis. "Hindsight reconstruction" cannot be used "to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Ecolchem, Inc. v. S. California Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000) (quoting In re Fine, 837 F.2d 1071 (Fed. Cir. 1988)). Rather, "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a

teaching or motivation to combine the prior art references.” *Id.* “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight.” *Id.* (quoting *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999)).

Indeed, as set forth above, the cited references teach away from the claimed invention. A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness. M.P.E.P. § 2145; *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (emphasis added). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d at 553, 31 USPQ2d at 1131 (emphasis added).

As set forth above, Yohe specifically teaches that updates to information contained in cached stores are updated in response to specific action requests by a requesting computer, not “as the updates occur.” (See Col 9 lines 29-45 (Open request), Col 9 lines 46-60 (Read request), Col 10 lines 21-32 (Write request), for example.) Thus, Yohe not only fails to teach instantaneously sharing and forwarding updates as the updates occur, but teaches away from the claimed element in that updates are passed along only as requested. Yohe teaches away from the claimed invention in that Yohe leads in a direction divergent from the path of the claimed invention.

Fairchild also teaches away from the claimed invention in that Fairchild teaches that the updated media files are not actually sent out with the notification, but are later downloaded separately by those desiring the updated media files. (Col 3 lines 48-54, Col 7 lines 41-51, for

example.) Therefore, though Fairchild teaches sending out a notification of updates when the updates occur, Fairchild does not teach the claimed limitation of “forwarding updates of the information (analogous to the media files of Fairchild) as the updates occur.” Thus Fairchild also leads in a direction divergent from the path of the claimed invention, and in a direction divergent from Yohe. Therefore, one of skill in the art, when presented with Yohe and Fairchild, would see only two divergent possibilities for sharing updates, both of which teach away from the claimed invention. As such, one of skill in the art would not be motivated to arrive at the claimed invention by the cited references.

Therefore, because the cited references fail to teach every claim limitation of claim 1, because there is no motivation to combine references in the manner suggested by the Examiner, because one of skill in the art would not expect success in doing so, and because the cited references teach away from the claimed invention, Applicants respectfully submit that claim 1 is not made obvious by the cited references.

Other claims:

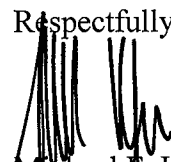
Independent claims 8, 14, and 21 contain similar limitations to those discussed in relation to claim 1, and are at least allowable for the same reasons. All other remaining claims depend from one of these independent claims, and are also therefore allowable. Applicants therefore respectfully request removal of all the rejections under 35 U.S.C. § 103(a).

CONCLUSION

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 6 day of December, 2007.

Respectfully submitted,



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